



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,369	03/06/2002	Samantha H. Stetson	12000097-0004-002	8236
26263	7590	07/11/2011		
SNR DENTON US LLP			EXAMINER	
P.O. BOX 061080			ALVAREZ, RAQUEL	
CHICAGO, IL 60606-1080				
			ART UNIT	PAPER NUMBER
			3682	
			MAIL DATE	DELIVERY MODE
			07/11/2011 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/092,369

Applicant(s)

STETSON ET AL.

Examiner

RAQUEL ALVAREZ

Art Unit

3682

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8, 11-13, 16-19, 21-22, 24, 31, 33, 35, 37, 72 and 74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 11-13, 16-19, 21-22, 24, 31, 33, 35, 37, 72 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of Filing was Filed (PTO-502)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 5/11/2011.
2. Claims 1, 8, 11-13, 16-19, 21-22, 24, 26, 31, 33, 35, 37, 72 and 74 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 8, 11-13, 16-19, 21-22, 24, 26, 31, 33, 35, 37, 72, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (6,128,663 hereinafter Thomas) in view of Official Notice.

With respect to claims 1, 8, 11-13, 16-19, 31, 33, 35, 72, 74, Thomas teaches displaying a message in conjunction with an advertisement on a World Wide Web Page (Abstract). Determining a banner advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page includes content other than the advertisement (i.e. content of the output requested including advertisement)(col. 4, lines 53-65); determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said banner advertisement and directs a user's attention to the banner advertisement (i.e. variant of the requested page including a greeting)(col. 4, lines 53-65 and col. 8, lines 64-66); determining targeting criteria associated with said message (i.e. taking into account demographics and information of

the requested page in order to display a variant of the page to the user)(col. 4, lines 63-65); receiving a request to serve said World Wide Web page and serving said World Wide Web page (col. 4, lines 53-65 and col. 8, lines 53 to col. 9, lines 1-9); serving said banner advertisement for display on said World Wide Web page such that at least a portion of the content other than the advertisement included in said World Wide Web page, tailoring said message based on said targeting criteria and serving said tailored message for display on said World Wide Web page (col. 4, lines 53-65 and col. 8, lines 53-65).

With respect to receiving personal information about the user from a user. Thomas teaches receiving personal information about the user (col. 2, lines 1-24). Thomas is silent as to the information being received from the user. Official Notice is taken that it is old and well known to receive personal information from the user such as user's name, age and gender when a user fills out an application and the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving personal information from the user in order to allow the user control of his or her information.

With respect to said tailored message being separate from the advertisement. Thomas teaches the user receiving requested content which includes advertisements (banner ads) and a variant of the requested page (tailored message) in a portion of the page (col. 4, lines 63-65).

With respect to the tailored message and the banner advertisement are simultaneously displayed to the user to include a portion of said personal information

and direct the user's attention to the banner advertisement. Thomas teaches the user will receive requested content which will include **advertising banner** and a appropriate variant (tailored message) of the requested content that includes greetings, etc. displayed with the requested content **or portion thereof** (col. 4, lines 60-65).

With respect to claims 21-22, Thomas further teaches tailoring said message based on external information (i.e. receiving demographic information from other sites)(col. 2, lines 64 to col. 3, lines 1-24).

Claim 17 further recites serving a second message when said tailored message is no longer to be displayed. Official Notice is taken that it is old and well known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have including serving a second message when said tailored message is no longer to be displayed in order to allow the customer to always receive or be exposed to a message.

Claims 24, 37,further recite that said tailored message is to be displayed proximal to the advertisement. Thomas is silent as to the location of the message in

proportion to the advertisement. Nevertheless, official Notice is taken that placing the message proximal to the ad or within the advertisement is old and well known to bring the user's attention to the ad.

Claim 26 further recites changing a display attribute within said tailored message. Official Notice is taken that changing display attribute within a message such as changing display color or image will bring the user's attention to the message.

Response to Arguments

5. **Argument #1:** Applicant argues that Thomas directs the user's attention away from the banner advertisement and toward the search result categories, and therefore has the opposite effect of the message recited in claim 1 and that in addition fails to include any personal information about the user.

Response to argument #1: The Examiner wants to point out that Applicant is concentrating in one embodiment of the Thomas and overlooking other embodiments/ teachings. Thomas clearly recites on col. 4, lines 60-65 **"Other modification could also be made such as providing a greeting, selecting an appropriate variant of the requested page or portion thereof, etc"** Thomas on col. 2, lines 64 to col. 3, lines 1-25, teaches collecting user's demographic to customize appropriate content to the user. As can be seen by Thomas above, the user receives an advertising banner and then in order to bring the user's attention to the advertising banner a customized greeting or variant of the page(tailored message) is displayed to the user.

6. **Applicant argument #2:** Applicant Additionally, even if Thomas suggests inserting a greetings into the webpage as depicted in Figure I 1 (which Applicants do not admit), a greeting (absent further details) does not specifically provide a message separate from a banner advertisement that is thematically related to said banner advertisement and tailored to include personal information and direct the user's attention to the banner advertisement, as recited in claim 1.

Examiner response #2: The Examiner disagrees with Applicant because Thomas teaches on col. 4, lines 58-65 " For example, the requested page often includes an advertising banner, and according to the invention, the particular advertising banner that is chosen to be transmitted with the requested page is determined, not randomly, but in accordance with the demographics identifier. Other modification could also be made such as providing a greeting, selecting an appropriate variant of the requested page or portion thereof, etc." As taught by Thomas above, the requested page of Thomas can contain banner ads and selecting an appropriate variant of the page (tailored message) such as a greeting to be displayed in the portion of the page. Therefore contrary to Applicant's arguments, Thomas teaches the **banner advertisements** which are part of the requested page and a separate **appropriate variant or greeting** (tailor message) of the requested page is displayed to the user in a **portion thereof**. The banner ads are separate from the appropriate variant of the page including greetings and are displayed simultaneously as **portion thereof** of the page.

7. **Applicant argument # 3:** Applicant argues that the Official Notice taken fails to cure the deficiencies of Thomas. For example, Applicant argues that even if the Official Notice were true, it does not specifically address banner advertisements.

Examiner response #3: The Examiner wants to point out the claims were rejected under the doctrine of 103 and therefore should be argued accordingly.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAQUEL ALVAREZ whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Namrata (Pinky) Boveja can be reached on (571)272-8105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3682

Raquel Alvarez
Primary Examiner
Art Unit 3682

R.A.
7/6/2011